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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,360	05/10/2002	Koichi Komoda	967 023	2576
20874 7590 11/26/2008 MARIAMA MULDOON BLASIAK & SULLIVAN LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202				
EXAMINER				
HASAN, SYED Y				
ART UNIT		PAPER NUMBER		
2621				
MAIL DATE		DELIVERY MODE		
11/26/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/031,360

**Applicant(s)**

KOMODA, KOICHI

**Examiner**

SYED Y. HASAN

**Art Unit**

2621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 10, 13, 21, 22, 26, 29, 42 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6, 10, 13, 21, 22, 26, 29 and 42 is/are allowed.
- 6) ☒ Claim(s) 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/9/2002, 6/7/2004, 6/10/2004, 9/13/2004 and 4/8/2005.

**DETAILED ACTION**

**Response to Arguments**

1. Applicant's arguments with respect to claims 6, 10, 13, 21, 22, 26, 29, 42 and 82 filed on 08/08/2008 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility "(Official Gazette notice of 22 November 2005), Annex IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim 82 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter as follows.

Claim 82 defines "computer readable storage medium having information indicating whether transfer of content is carried out .....". Here "information indicating" is merely non-functional descriptive material stored on the computer readable medium. This non-functional descriptive material does not create any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer.

Examiner recommends either cancelling the claim or adding language to the claim that indicates an action taking place by the computer readable storage medium. This claim language needs to be supported by the specification

***Allowable Subject Matter***

3. Claims 6, 10, 13, 21, 22, 26, 29 and 42 are allowed.
4. The following is a statement of reasons for the indication of allowable subject matter:

The present invention of claims 6, 10, 13, 21, 22, 26, 29 and is directed to a playback/recording apparatus for performing transfer of contents recorded on an erasable storage medium

Independent claim 6 identifies the unique distinct feature "wherein, when performing transfer of the contents, the contents are reproduced by the playback means and outputted and, when the output of the detection means indicates that the contents are copy-inhibited, the contents are erased from the first storage medium by the erasing means and, simultaneously, the contents are recorded on the second storage medium by the recording means, thereby transferring the contents."

The closet prior art, Aoyama et al (US 6810200) discloses a playback/recording apparatus for performing transfer of contents recorded on an erasable storage medium said playback/recording apparatus comprising a playback/erasing apparatus as a first apparatus (fig 2, 1080 and 1071, col 6, lines 10 – 16, illustrates the combination of CD 1080 and data storage unit 1071 as playback and fig 2, 1070, col 6, lines 10 – 24 deletes the data, comprise the first apparatus) a recording apparatus as a second apparatus (fig 2, 1070 and 1090, and fig 3, 1200 and 1090, col 6, lines 55 – 61, comprise recording apparatus) and a transmission line such as a transmission cable or the like for connecting the first and second apparatuses (fig 3, 1090, col 6, lines 65 – 67, SD card 1090 loads music data and becomes the transmission media)

said first apparatus comprising:

transfer of contents between itself and the second apparatus (col 11, lines 1 – 8, illustrates copying of data from CD to HD and SD card)

a playback means for reproducing contents recorded on a first storage medium (fig 2, 1010, col 5, lines 41 – 43 reads data from CD) and outputting the reproduced contents (col 6, lines 10 – 15, outputs the reproduced contents on SD and data storage)

a detection means for detecting copyright information of the contents (fig 2, 1020, col 5, lines 60 – 67, judges or detects copyright information)

an erasing means for erasing the contents from the first storage medium (col 10, lines 9 – 13, illustrates data from HD being deleted as soon as it is written onto SD card)

said second apparatus comprising:

transfer of contents between itself and the first apparatus (fig 2, 1020, col 6, lines 5 – 9 illustrates transfer of contents)

a recording means for recording the contents on a second storage means (fig 2, 1090, col 6, lines 5 – 8, writes data on SD card)

wherein, when performing transfer of the contents, the contents are reproduced by the playback means and outputted and, the contents are erased from the first storage medium by the erasing means, and the contents are recorded on the second storage means by the recording means, thereby transferring the contents. (rejected based on the information contained above)

However Aoyama et al does not disclose a first and second authentication means for performing mutual authentication, an encryption means for encrypting the output from the playback and a decryption means for decrypting the encrypted data

On the other hand Kamibayashi et al teaches a first and second authentication means for performing mutual authentication (first authentication fig 5, 6c, second authentication fig 5, 13d and mutual authentication fig 5, col 7, lines 58 - 65, col 8, line 24 to col 9 line 40) an encryption means for encrypting the output from the playback (col 5, lines 29 – 31) and a decryption means for decrypting the encrypted data (col 12, lines 4 – 9)

Also, the erasing that Aayoma discloses for the first recording medium is not the first recording medium but an interim storage medium. Hence the original storage medium does not get erased (col 2, line 65 to col 3, line 4). Aoyama does not disclose erasing of the first recording medium.

Hence claim 6 is allowed.

Since claim 21 is dependent on claim 6, therefore it is also allowed.

Independent claim 10 identifies the unique distinct feature "wherein, when performing transfer of the contents, mutual authentication is carried out between the first authentication means and the second apparatus, and the contents are reproduced by the playback means and outputted and, when the output of the detection means indicates that the contents are copy-inhibited, the contents are erased from the first storage medium by the erasing means."

Hence claim 10 is allowed for the reason mentioned above.

Since claims 26, 29 and 42 are dependent on claim 10, therefore they are also allowed.

Independent claim 13 identifies the unique distinct feature "wherein, when performing transfer of the contents, mutual authentication is carried out between the first authentication means and the second apparatus, and the contents are reproduced by the playback means and outputted and, when the output of the detection means indicates that the contents are copy-inhibited, the data of the contents are encrypted by the encryption means and outputted, and the contents are erased from the first storage medium by the erasing means."

Hence claim 13 is allowed for the reason mentioned above..

Since claim 22 is dependent on claim 13, therefore it is also allowed.

Therefore claims 6, 10, 13, 21, 22, 26, 29 and 42 are allowed over prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-



1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./  
11/12/2008

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621